

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of : Cian E. O'Meara et al.
Serial No. : 09/740,201
Filed : December 18, 2000
For : Allocation Of Location-Based Orders To Mobile Agents
Examiner : BOYCE, Andre D.
Art Unit : 3623
Confirmation No. : 4327
Docket No. : 920673-907251

Reply Brief

Honorable Director of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Examiner's Answer, beginning at page 7, summarizes Appellant's arguments in the Appeal Brief as comprising arguments (1), (2) and (3). For ease of reference, this Reply Brief will use the same headings to identify the points being addressed, but Appellant notes that "argument 1" is misleading as a label for the three independent reasons given for patent eligibility of claims 1-23 in the Appeal Brief.

"Argument (1)"

In appealing the rejection of claims 1-23, Appellant put forward three independent reasons why patent eligibility should be recognized under section 101. The first was that the claims satisfied the "machine" branch of the test. The second was that the claims satisfied the "transformation" branch of the test. The third was that the rejection was improperly based solely on the "machine or transformation" test. The Examiner did not consider these separately (and as

will be seen, there is little evidence that they were considered at all, either together or separately). To ensure that these three individual issues remain distinct, they will be labelled (i), (ii) and (iii).

(i)

In relation to the "machine" branch of the test, Appellant first considered the *August 2009 Interim Instructions* and carefully explained why these guidelines should lead to a recognition of patent eligibility under the "machine" branch of the test. This argument was not even referred to in the Examiner's Answer, and stands unrebutted.

Then, Appellant considered the seven indicators laid down in the *July 2010 Interim Guidance* and arguments were advanced as to why these too were believed to lead to a conclusion of patent eligibility. The Examiner's Answer again failed to address or refer to this argument, which stands unrebutted.

(ii)

In relation to the "transformation" branch of the test, Appellant argued for transformation of two articles: the ordering server, and the data representing agents and locations. Again this argument does not appear to have received any consideration and is not referred to in the Examiner's Answer, and it stands unrebutted.

(iii)

As regards the third reason, namely that the rejection was improper for relying solely on the "machine or transformation" test, Appellant explained in detail why, despite lip service being paid to *Bilski*, there was no evidence in the rejection that the Examiner had given consideration to anything other than the "machine or transformation" test. The Examiner's Answer does not address this point in any respect, and the argument stands unrebutted.

Reference was also made to the additional factors or indicators which are indicated to be appropriate in the *101 Method Eligibility Quick Reference Sheet*, but those factors were also not addressed in the Examiner's Answer and remain unrebutted.

In summary in relation to each of (i) to (iii), Appellant contends that the Examiner failed to address any of the arguments made in the Appeal Brief under the various headings which the Examiner has grouped together as "argument 1", and none of these arguments are rebutted in the Examiner's Answer.

It is true that the Examiner's Answer does contain a section, beginning towards the bottom of page 7 and running to the middle of page 8, that claims to address "argument 1". But that section contains nothing other than a wholesale repetition, almost verbatim, of the very same section 101 rejection as can be found in the Final Office Action dated October 14, 2010 and repeated on page 5 of the Examiner's Answer. That hardly is a refutation of Appellant's arguments, and the rejection should be reversed.

"Argument 2"

This heading relates to the issue of how much weight, if any, should be accorded to the preamble. The Examiner has advanced a new argument in this regard, and concentrates on the isolated phrase "steps of the method, which comprise".

The argument begins by noting that because the word "comprising" is open-ended, the method of claim 1 may include additional unspecified steps and that the ordering server may carry out such unspecified steps.

Pausing at this point, Appellants agree that "comprising" is open-ended, and that the claimed method may, in practice, include additional unspecified steps, and also that such unspecified steps could be carried out by the ordering server.

However, it is submitted that the Examiner then takes this argument too far in saying "As a result the ordering server may simply carry out steps not explicitly recited in the method claim" - Appellants understand the Examiner to be alleging that the ordering server may **only** carry out steps which are not explicitly recited, i.e. not carrying out the actual steps of the method at all. Appellants disagree that the claim could have this meaning.

The language of the claim is clear. There is a computer implemented method, and it comprises, i.e. includes, steps (a) to (e). Those steps in combination (with or without further steps) constitute "the method" of the claim. The claim further includes the limitation of "said method being carried out by an ordering server programmed to carry out the steps of the method, which comprise [steps (a) to (e)]".

Thus, for the claimed method to be carried out, the ordering server must carry out the steps of the method, regardless of whatever else it might do. A suggestion that the ordering server might carry out ancillary and unspecified steps, but not the claimed method steps, is contradicted by the claim language.

This last point, i.e. that the ordering server must be programmed to carry out the steps of the claimed method, (a) to (e), strongly echoes the first reason given for why the claim meets the "machine" branch of the test. With apologies for the repetition, Appellants wish to point out the similarity between the preamble language and the *August 2009 Interim Instructions* where it was stated that:

For computer implemented processes, the "machine" is often disclosed as a general purpose computer. In these cases, the general purpose computer may be sufficiently "particular" **when programmed to perform the process steps**. Such programming creates a new machine because a general purpose computer, in effect, becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software. **To qualify as a particular machine under the test, the claim must clearly convey that the computer is programmed to perform the steps of the method** because such programming, in effect, creates a special purpose computer limited to the use of the particularly claimed combination of elements (i.e., the programmed instructions) performing the particularly claimed combination of functions. If the claim is so abstract and sweeping that performing the process as claimed would cover substantially all practical applications of a judicial exception, such as a mathematical algorithm, the claim would not satisfy the test as the machine would not be sufficiently particular. [emphasis added]

Before leaving "Argument 2", Appellants note that Appellant's argument and analysis based on In Pitney Bowes, Inc. v. Hewlett-Packard Co. was not addressed or rebutted. Nor was Appellant's argument regarding claim 23 which is clearly and explicitly directed to a method of operating an ordering server, and which even more strongly is tied to a particular machine by the language of the claim. A method of operating an ordering server can never be an abstract idea. Again, the Examiner is in error and should be reversed.

"Argument 3"

The Examiner has clarified that the amendment proposed to claim 35 would have overcome the remaining rejection to this claim had it been entered. Accordingly, and assuming the Board is in agreement, it is respectfully argued that a statement under 37 CFR 41.50(c) would

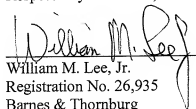
be appropriate as there appears to be agreement between Appellant and Examiner as to the allowable form of claim 35.

Summary

Given the above, it is submitted that the Examiner's rejections are in error and should be reversed, and insofar as claim 35 is concerned, with entry of the proposed amendment to claim 35, the issue would be moot. Reversal of the Examiner, with the exception of claim 35, is therefore solicited.

February 9, 2012

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "William M. Lee, Jr.", is written over a horizontal line.

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